Paper No. 7
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THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Carolina Chem-Strip of Alamance, Inc.

Serial No. 75/232,074

Jeffrey A. Andrews of Vernon Vernon Wooten Brown Andrews & Garrett, P.A. for Carolina Chem-Strip of Alamance, Inc.

Ronald McMorrow, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Hanak, Hohein and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Carolina Chem-Strip of Alamance, Inc. has filed an application for registration of the mark “CAROLINA CHEM-STRIP and design” (with the word “Carolina” disclaimed) in the special form shown below:

Carolina Chem-Strip

for “cleaning, stripping, descaling and degreasing metal appliances, machinery, fixtures, vehicles and assorted parts to remove paint and other finishes,” in International Class 37.[1]

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, “CAROLINA CHEM-STRIP and design” when used on its metal cleaning and stripping services, so resembles the registered mark, “CHEMSTRIP” for “stripping agents for surface coatings and/or deposits,” as to be likely to cause confusion, or to cause mistake, or to deceive.[2]

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal to register.

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[1] Serial No. 75/232,074, filed January 27, 1997, alleging first use on November 9, 1981.

[2] Registration No. 936,775, issued on June 27, 1972. The registration sets forth a date of first use of February 7, 1964 and a date of first use in commerce of January 1, 1965; renewed.

Applicant argues that the marks are clearly distinguishable when considered in their entireties. Applicant contends that the design feature is a significant element in its composite mark, and further, that its own usage of "CHEM-STRIP" (hyphenated) is distinguishable from registrant's use of "CHEMSTRIP" (without a hyphen). Applicant also points to seventeen years of contemporaneous use without complaints from registrant, and no instances of actual confusion on the part of their respective customers.

By contrast, the Trademark Examining Attorney contends that the two marks are "…highly similar in appearance, sound, connotation and commercial impression." (brief, p. 3). He points out that prospective customers cannot use the design portion of the composite mark to call for applicant's services, and because the word "CAROLINA" is geographically descriptive, the dominant portion of applicant's mark is "CHEM-STRIP." He takes the position that applicant has appropriated registrant's mark and simply added other subordinate matter to it. He contends that the overall marks are "…highly similar in connotation since both suggest a process of using a chemical compound to strip a surface or object." (brief p.3).

In the course of rendering this decision, we have followed the guidance of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), which sets forth

the factors that should be considered, if relevant, in determining likelihood of confusion under Section 2(d) of the Act.

In testing for likelihood of confusion, we turn first to an analysis of the similarity or dissimilarity of the marks. As applicant points out, it is not proper to dissect a mark, focusing on a single element while excluding all others. On the other hand, our principal reviewing court recognizes that one feature of a mark may be more significant than other features, and that it is proper to give greater force and effect to that dominant feature. *See* *Giant Food, Inc. v. Nation's Foodservice, Inc*., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). In this regard, we agree with the Trademark Examining Attorney that registrant's mark, "CHEMSTRIP," is virtually identical to the term "CHEM-STRIP," which is the dominant element of applicant's composite mark. While such designation may well suggest a "chemical" process used for "stripping" a surface of paint, other finishes, or deposits, suggestive marks are, nonetheless, deserving of an appropriate scope of protection.[3] Furthermore, the insertion of a hyphen between the two syllables of the term "CHEM-STRIP" in applicant's mark is a *de minimis* change that would likely go unnoticed by most consumers.

Additionally, inasmuch as applicant is a North Carolina corporation having its headquarters and main facility in Burlington, North Carolina, with a second plant located in Fountain Inn, South Carolina, the geographically descriptive (and hence, disclaimed) term "Carolina" must be deemed to be subordinate matter.

Finally, as a non-literal element, the design feature is not something potential or actual consumers can verbalize.

Turning to the goods and services, it is well settled that goods and/or services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods and services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the similarity of the marks employed thereon, to the mistaken belief that they originate from or are in some way associated with the same producer. *See Turner Entertainment Co. v. Nelson*, 38 USPQ2d 1942 (TTAB 1996) [consumers familiar with opposer's "GILLIGAN'S ISLAND" television situation comedy series and licensed collateral products would be likely to believe upon encountering

[3] In spite of applicant's repeated allegation that registrant's mark is weak, we find that there is nothing in the record to support

applicant's mark "GILLIGAN'S ISLAND" for sunning products, that the goods were somehow associated with the same entity]; *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) ["Steelcare Inc." for refinishing of furniture, office equipment, and machinery for others, and "Steelcase" for office furniture and accessory items, is likely to cause confusion]; and *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) [purchasers encountering "21 Club" for shirts would be likely to mistakenly assume these goods were in some way associated with registrant's "The '21' Club" for restaurant services and collateral products].

In this context, we agree with the Trademark Examining Attorney that "…applicant's services and the registrant's goods are closely related because they perform identical functions…" and that "…applicant's services necessarily involve the use of goods similar to the registrant's [stripping agents]." (brief, p. 5). In fact, in its appeal brief, applicant does not even contest the close relationship of registrant's goods to applicant's services.

We turn next to applicant's allegations that there have been no instances of actual confusion during a period of seventeen years of simultaneous use by applicant and registrant of their respective marks. The fact, however, that applicant

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this charge.

has not encountered any instances of actual confusion is not persuasive of a different result herein, because there is no evidence in the record about the extent of applicant's sales and advertising of its services under its "CAROLINA CHEM-STRIP" mark. Further, while applicant claims to have used the mark "CAROLINA CHEM-STRIP" on its services since 1981, we have no evidence that the marks "CAROLINA CHEM-STRIP" and "CHEMSTRIP" have ever been used contemporaneously in the same geographical area. Thus we cannot tell whether there has been sufficient opportunity for confusion to occur. These factors materially reduce the probative value of applicant's argument on the matter of actual confusion. Moreover, the test under Section 2(d) of the Act is likelihood of confusion, not actual confusion. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Finally, it goes without saying that if there is any doubt about likelihood of confusion, it must be resolved in favor of registrant, the prior user. *Geigy Chemical Corporation v. Atlas Chemical Industries, Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971)

Decision: The refusal to register is affirmed.

E. W. Hanak

G. D. Hohein

D. E. Bucher

Administrative Trademark Judges,
Trademark Trial and Appeal Board